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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,885	09/29/2003	Robert A. Breyer	005242.00138	5372

22907 7590 03/21/2005

BANNER & WITCOFF  
1001 G STREET N W  
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WASHINGTON, DC 20001

EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/671,885

Applicant(s)

BREYER ET AL.

Examiner

Umakant K. Rajguru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 10-15, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. A response has been filed on January 3, 2005. Two information disclosure statements are filed one each on February 3 and 4, 2005.
2. Claims now under examination are 1-6, 8 and 9.
3. Applicant's election with traverse of Group I, claims 1-9 in the reply filed on January 3, 2005 is acknowledged. The traversal is on the ground(s) that the process of claims 10-19 cannot be used to make an article out of sand as set forth by the examiner. This is not found persuasive because:

- a. It is obvious and also possible to use the claimed process for particles of sand which are similar at least physically to the particles of wood and
- b. Applicants have not provided any proof or evidence to support their statement that the process is limited to make only wood composite and no other composite.

The requirement is still deemed proper and is therefore made FINAL.

Rejection of claims 1, 2, 5, 6, 8 and 9 under 35 USC 102(b) (see item 6 of prior Office action of October 14, 2004) is now withdrawn.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 2, 5, 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tinkelenberg et al (US 4,282,119).

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6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tinkelenberg et al (US 4,282,119) as applied to claim 1 above, and further in view of Guilbert et al (US 2004/0062920).

Please refer to same Office action for these rejections.

7. Applicant's arguments filed January 3, 2005 have been fully considered but they are not persuasive.

It is to be noted that the recently added limitation to the scope of instant claim 1 is related to a process and not the composition. It is the patentability of the composite (and not that of process step) that is under examination. The prior art discloses a wood composite that reasonably appears to be either identical or only slightly different than the claimed one. It is up to the applicants <sup>to</sup> establish that the composite of prior art is patentability distinguishable from the claimed one in order to prove nonobviousness of claimed composite.

Applicants' statement on page 7 (of above response) that "there is absolutely no suggestion of reacting the protein with formaldehyde" cannot be agreed with since Tinkelenberg in column 2, line 1, discloses "combining proteins". One of ordinary skill will obviously interpret "combining" to mean "reacting".

Applicants refer to example 1 of Tinkelenberg. It is the examiner's position that examples illustrate the invention; they do not limit the invention.

Applicants' comments about Guilbert (on page 8) are not persuasive since Guilbert is secondary reference, relied upon solely for its teaching (which is relevant to disclose of Tinkelenberg) of use of proteins as scavengers of formaldehyde.

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication from the examiner should be directed to U.K. Rajguru whose telephone number is (571) 272-1077. The examiner can generally be reached on Monday-Friday 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



U.K. Rajguru/dh  
March 16, 2005



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700